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October 30, 2002

U.S. Patent and Trademark Office  
Attn: Assistant Commissioner for Patents  
Box DAC  
Washington, DC 20231

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**GROUP 360**

Re: **Petition for Access to Pending Application Under 37 CFR § 1.14(j);  
09/618,744 (Pending)**

Dear Sir or Madam:

Enclosed please find the following documents:

1. Petition for Access to Pending Application Under 37 CFR § 1.14(j);
2. A self-addressed postage paid postcard for your use to indicate receipt of the enclosed documents; and
3. Check No. 522416 in the amount of \$130.00.

Sincerely,

**Gray Gary Ware & Preidenich LLP**

Edward H. Sikorski  
esikorski@graycary.com

Admitted to practice in California and Virginia

EHS:jf  
Enclosures  
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PATENT

Attorney Docket No. &lt;none&gt;

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/618,744 (Pending).

Inventor: Charles E. HILL

Filed: July 18, 2000

For: ELECTRONIC CATALOG SYSTEM AND METHOD

(Title may have been amended)

11/05/2002 DTESSEM1 00000039 09618744

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GROUP 3600

## PETITION FOR ACCESS TO PENDING APPLICATION

UNDER 37 CFR § 1.14(j)

*Hon. Commissioner of Patents and Trademarks**Box DAC**Washington, D.C. 20231**Attn: Assistant Commissioner for Patents*

Sir:

Pursuant to Title 37 of the Code of Federal Regulations Section 1.14(j), petitioner respectfully requests access to, or copies of, the entire file history of the above-identified patent application, which is now pending before the United States Patent and Trademark Office ("PTO"). Although the application does not appear to qualify for access under the various categories set out in Rule 1.14, petitioner submits that access is nevertheless "warranted by other special circumstances," 37 C.F.R. § 1.14(j), and that

"special circumstances exist which warrant petitioner being granted access to all ... of the application," 37 C.F.R. § 1.14(j)(2).

1. The Application May Contain Information Relevant To the Construction Of Terms Appearing In the Claims Of U.S. Patents 5,528,490; 5,754,864; 5,761,649; 6,029,142; and 6,131,088.

It is petitioner's understanding that the requested application 09/618,744 ("the '744 application") is a continuing-type application claiming priority to series of prior applications, the oldest of which matured as U.S. Patent 5,528,490 ("the '490 patent"). Other offspring from the '490 patent include four other patents, U.S. 5,754,864; U.S. 5,761,649; U.S. 6,029,142; and U.S. 6,131,088, two of which (the '088 and '864 patents) are in the '744 application's direct line of dependency.

The law is clear that each of these patents' file histories is relevant to the construction of claim terms appearing in each of the others. *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 USPQ2d 1109, 1113 (Fed. Cir. 1999) (relying on statements made during prosecution of a first patent to construe the claim language of a second patent, wherein both patents were continuations from a common application and used similar claim language).

It is with equal force that statements and/or amendments made during the prosecution of the pending '744 application (the application to which this petition requests access) may affect the scope and/or construction of those same patented claims. *Cordis Corp. v. Scimed Life Sys., Inc.*, 982 F. Supp. 1358, 1364 (D. Minn. 1997) (agreeing with other courts that information contained in related pending and abandoned patent applications may be relevant to claim construction of the claims of the patent in suit); *Avery Dennison Corp. v. UCB SA and UCB Films PLC*, No. 95 C 6351, 1996 WL 633986, at \*1 (N.D. Ill. Oct. 29, 1996) ("The probability that probative information could be discovered is further enhanced by the fact that UCB has limited its request to files of applications which 'claim the benefit of the filing date' of the family of applications leading to the patents in suit."). Continuing applications are particularly relevant to the claim construction of a prior-issued patent. *Central Sprinkler Co. v.*

*Grinnell Corp.*, 897 F. Supp. 225, 229 (E.D. Pa. 1995) ("It is possible that a PTO examiner might deny a particular claim in a CIP application by finding that the allegedly new claim was included within the original application. In that situation, the scope of the issued patent has just been defined, in the course of a different patent's prosecution.").

Because the impact that the requested application's file history may have on the inventions claimed in the five (5) aforementioned patents remains a mystery, petitioner submits that access is indeed warranted, not only by petitioner but also by the public at large. To hold otherwise would be to keep the public unjustifiably in the dark as to the scope of five (5) issued patents.

In the case at hand, the justification for access is even more apparent. The applicant/patentee of the requested application has already asserted at least the '490 patent in the courts. *See Charles E. Hill & Assoc., Inc., v. Compuserve, Inc.*, 65 F. Supp. 2d 924 (S.D. Ind. 2000). Thus, although access by the public is believed to be warranted to any application whose ancestors have been patented, access to the requested application is even more appropriate, so that any impact that the application might have on the scope of litigated patented claims may be understood.

Moreover, the statements or other information contained in the pending application are not privileged. *Bott v. Four Star Corp.*, 675 F. Supp. 1069, 1075 (E.D. Mich. 1987) ("Information as to pending patent applications is important in patent litigation; such applications may contain admissions. The information is not privileged."). Accordingly, as between a patent applicant's (presumed) desire to withhold from public access the file history of a pending continuing-type application whose parents have issued, and the public's right to access that application in order to ascertain the impact it may have on the scope of patented claims (here, the claims of five (5) patents), petitioner submits that the latter must prevail.

It is for at least these reasons that petitioner believes access is warranted under the Rule; namely, to gain a full and fair understanding of the scope and construction of the claims of the aforementioned five (5) patents.

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2. If Access to the Entire File History is Denied, then Access to the Prior Art is Respectfully Requested.

If the PTO denies petitioner's request for access to the entire '744 file history then, in the alternative, petitioner requests that it be granted access to or copies of part of the application, 37 C.F.R. § 1.14(j), specifically the public prior art documents that may be contained and/or cited therein. While the patent applicant's statements and other contents of the application are clearly relevant to the construction of the patented claims, so too are the pieces of prior art. *See Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1301, 50 USPQ2d 1900, 1907 (Fed. Cir. 1999) (noting that prior art confines and cabins the claims, potentially affecting the breadth of both pioneer and non-pioneer patents). Petitioner believes that, while access to the entire file history is warranted, access should at the very least be provided to the prior art documents contained and/or cited therein; those documents are, by their very nature, public.

On a more practical level, much of the prior art cited in the aforementioned five (5) patents is missing from their respective file wrappers, suggesting that the PTO has moved those references to the pending '744 application's file wrapper. The list of prior art in those patents spans upward of four (4) pages, at least in U.S. 6,029,142, much of it being articles and other publications that are not easily found from other sources. Thus, petitioner requests access to the '744 application so that these missing references may be obtained.

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If the Office grants this petition, then the undersigned respectfully requests a telephone call at 619.699.2645 so that arrangements may be made to obtain the copy.

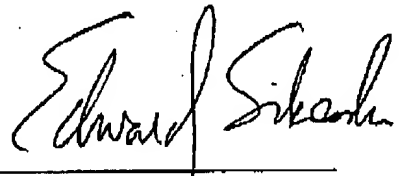
Enclosed is Check No. 52246 in the amount of \$130.00 as required by Title 37 of the Code of Federal Regulations Sections 1.14(j)(1) and 1.17(h).

Respectfully submitted,

GRAY CARY WARE FREIDENRICH, LLP  
401 B Street, Suite 2000  
San Diego, CA 92101-4240

Date: October 30, 2002

By:



Edward H. Sikorski

Reg. No. 39,478